

Appln. No. 10/003,011

Attorney Docket No. 8627-213
Client Reference No. PA-5270-RFB**II. Remarks**

Reconsideration and re-examination of this application in view of the following remarks is herein respectfully requested.

Claims 1-22 remain pending.

Claim Rejections - 35 U.S.C. §103(a)

Claims 1, 2, and 4-6 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,443,971 to Boylan (Boylan) in view of U.S. Patent No. 5,681,347 to Cathcart, et al. (Cathcart).

Applicant suggests that a *prima facia* case for obviousness has not been established by the Examiner. "The Examiner bears the initial burden of factually supporting any *prima facia* conclusion of obviousness." MPEP §2142. The Examiner has not provided factual support that the subject matter of claim 1 would have been obvious at the time of the invention to a person of ordinary skill in the art.

Applicants respectfully submit that the filter 28 of Boylan is not a grasping portion as the examiner contends. Rather, the filter 28 is a deployable device that is released and separated from the filter holder 21. As the filter 28 is released, it expands and detaches from the rest of the device to push embolic material against the wall of the vessel (abstract, col. 4, ln. 65 – col. 5, ln. 8). The reference does not teach or suggest that the filter 28 is configured grasp anything, rather it acts to merely displace the embolic material. Therefore, the filter 28 clearly does not act as a grasping portion of a grasping device. Accordingly, Boylan does not expressly or impliedly suggest the grasping portion provided in claim 1.

Similarly, Cathcart also teaches a deployable filter, not a grasping portion. As such, the grasping device of claim 1 is not taught or suggested in Boylan, Cathcart,

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or the combination thereof. Accordingly, applicants respectfully submit that claim 1 is patentable over the cited art for at least the reasons provided above.

Claims 2 and 4-6 depend from claim 1 and are, therefore, patentable for at least the same reasons as claim 1.

Claim 3 was rejected under 35 U.S.C. §103(a) as being unpatentable over Boylan in view of Cathcart, in view of U. S. Patent No. 5,330,484 to Gunther, et al. (Gunther).

Claim 3 depends from claim 1 and is, therefore, patentable for at least the same reasons given above in support of claim 1.

Claims 8-22 were rejected under 35 U.S.C. §103(a) as being unpatentable over Boylan in view of Cathcart, and in view of U.S. Patent No. 5,098,440 to Hillstead (Hillstead).

Claims 8-22 depend from claim 1 and were rejected based on the combination of Boylan, Cathcart, and Hillstead. As discussed above Boylan and Cathcart do not teach or suggest the grasping device of claim 1 and while Hillstead teaches two wire loops the combination of these references is improper. As stated in MPEP § 2143.01, “the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggest the desirability of the combination.” *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Cathcart and Boylan relate to filter deployment devices, and do not teach or suggest the combination of the grasping portion along with the elongated control member. As noted above, the examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. No factual support has been provided by the examiner that the prior art suggests the desirability of a grasping portion in combination with an elongated control member and a sheath. Therefore,

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the combination of Boylan or Cathcart with Hillstead is improper. Claims 8-20 depend from claim 1 and are, therefore, patentable for at least the same reasons as given above in support of claim 1.

Further, independent claims 21 and 22 include a loop or grasping portion similar to claim 1. As such, the combination of Boylan, Cathcart, and Hillstead as applied to claims 21 and 22 is improper based on the same reasoning applied to claim 1 above.

In addition, with regard to claims 10-13, clearly each of the limitations provided in the claim with respect to the loops of the grasping portion are not taught or suggested by the references cited by the examiner. Similarly, with respect to claims 15-20 and 22, the relationship of attachment between the loops and the elongated control member cannot be taught or suggested by the combination of references provided by the examiner, due to the fact that none of the references include both a loop and elongated control member. Accordingly, applicants respectfully request withdrawal of the rejections under 35 U.S.C. §103.

Conclusion

In view of the above amendments and remarks, it is respectfully submitted that the present form of the claims are patentably distinguishable over the art of



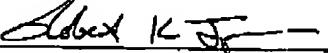
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record and that this application is now in condition for allowance. Such action is respectfully requested.

Respectfully submitted by,

Dated: February 8, 2006



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